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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,677	07/18/2003	Stephen Allen Johnson	3971-13-CON	3654

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EXAMINER

RINEHART, KENNETH

ART UNIT	PAPER NUMBER
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3749

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/622,677

Applicant(s)

JOHNSON ET AL.

Examiner

Kenneth B Rinehart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26, 29 and 33-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26, 29 and 33-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2003, 29 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/23/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Response to Arguments***

Applicant's arguments filed 7/29/04 have been fully considered but they are not persuasive. The applicant argues that the subject and provisional applications each reference a number of carbon compounds that would be understood by one of ordinary skill in the art to promote reduction of iron oxides. The examiner disagrees. The carbon is disclosed as preventing fugitive emissions and replacing heat input requirements, increasing the cohesiveness of the final material and dust suppression and not to promote the reduction of iron oxides. Consequently, one would not conclude that, at the time each application was filed, the inventors had possession of an iron-containing additive containing at least one carbon compound to promote reduction of iron oxides in the iron-containing additive. Regarding applicant's arguments concerning claims 1, 19 and 24 and the ash fusion temperature characteristic selected from the group that consisting of initial deformation temperature, softening temperature, hemispherical temperature, and fluid temperature, the applicant appears to be relying on inherency and implication to provide support for this language in the method claims. However, there is no support for these terms in the disclosure as filed. Instead, the applicant relies upon Exhibit A, and a discussion on pages 22 and 23 of the response of how the ash is pressed into a mold to form a triangular pyramid, to support his argument that the AFT limitations for these method claims are contained in the disclosure as filed. This argument is not persuasive. Additionally, the applicant argues that the iron containing additive lowers the T250, and through inherency it will lower the AFT properties. This argument is not persuasive as the disclosure makes no reference to the AFT properties. Regarding the requirement that during solid fuel coal combustion the iron bearing material fluxes the ash slag

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to produce a composite slag, there is not reference in the specification to a composite slag. Regarding the sub bituminous argument, this argument is not persuasive as PRB could be something other than sub-bituminous. Regarding applicant's arguments concerning claims 3, 17, 22, and 36 there is no reference in the disclosure to AFT. Regarding the limitations 0.5 to about 2.5 percent and 0.1 and 10 weight percent, the numerical limitations are contained in the reference, however the combination of limitations are not. The additives are not used to reduce iron. The applicant states that "Examiner's failure to cite the Shepard Patent as prior art under 35 USC 102(e) indicates that the Examiner is in agreement that the pending claims are supported by the Provisional Application". This conclusion is entirely erroneous as the claims were rejected under 35 USC 112 first paragraph.

Information Disclosure Statement

The information disclosure statement filed 7/29/04 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. There is not statement of relevance of JP11-94234.

Claim Objections

Claim 47 is objected to because of the following informalities: Claim 47 refers to "I a wet bottom boiler. Appropriate correction is required.

Claim Rejections - 35 USC § 112

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-26, 29, 33-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1, refers to the at least one carbon compound promoting reduction of iron oxides; one ash fusion temperature characteristic selected from the group consisting of initial deformation temperature, softening temperature, hemispherical temperature, and fluid temperature, the iron bearing material fluxes the ash slag to produce a composite ash slag which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 2, refers to sub-bituminous coal which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 3, refers to initial deformation temperature, softening temperature, hemispherical temperature, and fluid temperature less than 2600 degrees which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 11, refers to the iron bearing material fluxes the ash slag to produce the ash slag which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the

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inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 14, refers to the concentration of iron-bearing material to solid fuel is from about 0.5 to about 2.5 weight percent which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 17, refers to melting point of the composite ash slag is less than 2600 degrees F which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 19, refers to at least one ash fusion temperature characteristic selected from the group consisting of initial deformation temperature, softening temperature, hemispherical temperature, and fluid temperature, fluxes the ash slag which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 20, refers to sub-bituminous coal which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 22, refers to the melting point of the composite ash slag is less than 2600 degrees F which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 24 refers to at least a portion of the iron bearing material fluxes the ash slag to produce a composite ash slag, wherein at least one ash fusion temperature characteristic selected from the group consisting of initial deformation temperature, softening temperature, hemispherical temperature, and fluid temperature, the iron bearing

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material fluxes the ash slag which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 29 refers to the iron-bearing material comprises about 0.1 to about 10 % of a carbon-containing compound which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 30 refers to and mixtures thereof which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 33, refers to at least a portion of the iron bearing material fluxes the ash slag to produce a composite ash slag which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 36, refers to the melting point of the composite ash slag is less than 2600 degrees F which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 37, 43, and 46 refer to step (ii) is performed and wherein the iron-bearing material is at least one of mill scale from steel production and dust from blast furnace gas cleaning equipment which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 38, 41, and 44 refer to the at least one ash fusion temperature characteristic is fluid temperature which was not described in the specification in such a way as to reasonably convey to one skilled

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in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 39 refer to low sulphur content which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 40, 42, 45 refer to low iron high alkali content which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 24 refer to I a wet bottom boiler which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth B Rinehart whose telephone number is 703-308-1722. The examiner can normally be reached on 7:30 -4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ira Lazarus can be reached on 703-308-1935. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

kbr


KENNETH RINEHART
PRIMARY EXAMINER